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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,686	04/06/2001	John Rizzotto	PAR-100US	5077

7590

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EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-3

Office Action Summary

Application No.

09/827,686

Applicant(s)

RIZZOTTO ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, and 18-26, drawn to a chewable flavor delivery system/oral tobacco substitute, classified in class 131, subclass 352.
 - II. Claims 10-17, drawn to a flavor delivery system, classified in class 426, subclass 640.
 - III. Claims 27-35, drawn to a tobacco substitute, classified in class 131, subclass 352.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II and II,III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination, Invention II – the flavor delivery system – does not require a water soluble flavoring ingredient, such as required in Invention I, nor does it require coffee or caffeine, or a sweetening agent, such as required in Invention III. The subcombinations of Invention I and Invention III each have separate utility such as stop-smoking aids.
3. Inventions I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention III has separate utility in that it provides the user with a product having caffeine/coffee and a sweetener. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, and the search required for Group III is not required for Group III, etc. restriction for examination purposes as indicated is proper.

6. During a telephone conversation with MR. James Simmons on Monday, June 10th a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9 and 18-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-17 and 27-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8 and 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchmann et al (US. Pat. No. 3,867,951).

Buchmann et al discloses a non-tobacco plant smoking substitute material which can be produced from cabbage leaves which are supplemented by means of additives, such as softening substances (glycerine) (corresponding to the claimed "humectant", and since the substitute consists of a food source, it follows that said humectant is obviously also "food-safe") and flavorings such as sugar – which is naturally water-soluble, but not water-containing – and molasses (corresponding to the claimed "flavoring ingredient/sweetening agent"). The moisture content of the tobacco substitute of Buchmann et al is preferably 1-10 percent (which corresponds to the claimed "at or below 8% by weight"). While Buchmann et al may not specifically state that the cabbage material has at least 30% intact cell walls, there is no language in the reference that would indicate that the cell walls of the plant material would *not* remain intact during the processing of the cabbage leaves to make the final tobacco substitute (i.e. use of extract of cabbage plant material, for instance). Therefore, it would follow that at least the cabbage leaves used in the substitute of Buchmann et al would have at least 30% intact cell walls. And since this is the case, it would follow that the flavoring

ingredients would be such that it would be capable of entering said cell walls of the plant since this must occur in order to appreciate the benefits of this ingredient in the final product (see cols, 1, 3-4).

Regarding claims 4-6 and 21-23, while Buchmann et al may not articulate that the granular form of its tobacco substitute is sized to pass a 16 or 20 mesh screen but be retained on a 20 or 30 mesh screen, Buchmann et al discloses that the grinding/communion process should be carried out in a careful manner so as not to impair the aroma of the final product (col. 3, lines 31-33). It also teaches that there will be smaller particles, as small as 5 micron, and substantially larger particles that will result from the communion process and both sizes will combine to give the intended effect for the finished product (col. 3, lines 20-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the particle sizes of the cabbage leaf particles to arrive at particles having the claimed mesh size in order to achieve the desired aroma and the intended binding effect as taught in Buchmann et al.

Regarding claims 2 and 19, Buchmann et al discloses that its tobacco substitute can be molded into a sheet, strands, flakes or the like.

Regarding claim 3 and 20, Buchmann et al also teaches that a particularly fine distribution of the substance, in colloidal particles (corresponding to the claimed "granular form"), is desirable.

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10. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchmann et al (US. Pat. No. 3,867,951) in view of Nonomura et al (US. Pat. No. 5,597,400).

Regarding claims 9 and 26, while Buchmann et al may not specifically state that the cabbage used in its tobacco substitute is green tobacco, this limitation is not deemed to impart any patentable distinction to the claims because green cabbage classified as *Brassica oleracea capitata* is well-known in the food art, as evidenced by the Nonomura et al reference (col. 11, lines 8-9). Further while Buchmann et al modified by Nonomura et al may not disclose that the cabbage of its tobacco substitute is "freeze-dried", the Applicant is reminded that these claims are product-by-process claims and, accordingly, the standards set forth in MPEP 2113 will be followed. Even though these claims are limited by and defined by the "freeze-drying" process, determination of patentability is based on the product itself, i.e. differences in product characteristics, and not on its method of production.

Further, In the event that any differences can be shown for the product of the product-by-process claims, as opposed to the product as taught by the reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (CAFC 1985).

Conclusion

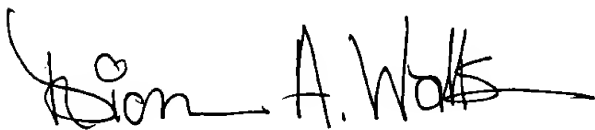
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Carroll (US. Pat. No. 3,369,551)
- Carroll (US. Pat. No. 3,369,552).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read "Dionne A. Walls", with a stylized flourish at the end.

Dionne A. Walls
June 14, 2002